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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/976,294 11/21/97 WESTERLAGE K 019743.0261

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BARTON E SHOWALTER
BAKER & BOTTS
2001 ROSS AVENUE
DALLAS TX 75201-2980

EXAMINER

COSIMANO, E

ART UNIT

PAPER NUMBER

2761

DATE MAILED:

07/27/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/976,294

Applicant(s)
Westerlage et al

Examiner
Edward R. Cosimano

Group Art Unit
2761



☒ Responsive to communication(s) filed on Nov 21, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 38-79 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 38-79 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Nov 21, 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit 2761

IMPORTANT NOTICE

Effective November 16, 1997, the Examiner handling this application will be assigned to a new Art Unit as a result of the consolidation into Technology Center 2700. See the forthcoming Official Gazette notice dated November 11, 1997 For any written or facsimile communication submitted **ON OR AFTER** November 16, 1997, this Examiner, who was assigned to Art Unit 2414, will be assigned to Art Unit 2761. Please include the new Art Unit in the caption or heading of any communication submitted after the November 16, 1997 date. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

Art Unit 2761

1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. The drawings are objected to because:

A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of claim(s) 48, 49 & 74 in regard to the claimed report must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).

Correction is required.

2.1 Applicant is required to submit a proposed drawing correction in response to this Office action. However, correction of the noted defect can be deferred until the application is allowed by the examiner.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, & § 1.84(o,p(5)).

4. Claims 51-57 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4.1 In regard to claim 51, it is unclear how a transmission of data may be received when the data has never been transmitted.

4.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under

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this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5.1 Claims 38-79 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Haendel (5,359,528) in view of Gooch (5,396,540).

5.1.1 In regard to the claims, Haendel ('528) discloses the determining of the location of a monitored vehicle using a GPS position determining system and the vehicle's odometer. This data as well as the applicable tax for the vehicle's location based on a gridwork of cells that define a region is recorded. The recorded data is then used to generate a report of the vehicle's log. However, this data is not transmitted to a remote central location as claimed.

5.1.1.1 In regard to the claims, Gooch ('540) discloses the determining of the location of a monitored vehicle using a GPS or LORAN-C position determining system. This position data is then transmitted to a remote central location that uses the position data to plot the vehicle's location with respect to a gridwork of cells that define a region.

5.1.1.2 Since the taxing authority of Haendel ('528) would operate from a central location as is common among for hire vehicles, i.e. taxis, shippers etc., it would have been obvious to one of ordinary skill at the time the invention was made that the system of Haendel ('528) could be modified to:

A) transmit the vehicle data to a central location as taught by Gooch ('540) using any suitable communications link absent applicant's showing of new and unexpected results from using a particular communications link.

B) use a GPS system to determine the vehicle's location.

5.1.1.3 As per the automatic determination of distance and the tax, since each of these features are taught by Haendel ('528), it would have been obvious to one of ordinary skill at the time the invention was made that these functions are performed automatically by the computer of Haendel ('528) to prevent the possibility of human error.

5.1.1.3.1 It is further noted that even if it could be shown that these functions are not performed automatically in Haendel ('528) then it would have been obvious to one of ordinary skill at the time the invention was made that the determination of distance and applicable taxes

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could be automated in the computer of Haendel ('528) to prevent the possibility of human error. Also, as the Court has stated it is not invention to broadly replace manual activity with an automatic activity that accomplishes the same result, (*In re Venner and Bowser*, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)).

6. Claims 38-79 are rejected under the judicially created doctrine of double patenting over claims 1-45 of U. S. Patent No. 5,694,322 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

6.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a system in which:

A) the position of a vehicle is determined;

B) the position of the vehicle is transmitted over a communications link to a remote location;

C) the transmitted data is correlated to one or more geographical taxing regions;
and

D) a tax based on mileage vehicle traveled within the taxing region is determined.

6.2 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Art of interest, is cited by the examiner.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached on (703)-305-9711. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

9.1 The fax phone number for **UNOFFICIAL FAXES** for this group is (703) 308-5357.

9.2 The fax phone number for **OFFICIAL FAXES** for this group is either (703) 308-9051 or (703) 308-9052.

07/20/98



Edward R. Cosimano

Primary Examiner A.U. 2761